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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,439	01/04/2002	Gregory Keith Rhyne	DANA-119P1	4493

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EXAMINER
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REIFSNYDER, DAVID A

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/035,439

Applicant(s)

RHYNE ET AL.

Examiner

David A Reifsnnyder

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5/02.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Drawings*

The drawings filed on January 4, 2002 are objected to for being clearly informal. In response to this office action, **Formal Drawings are Required**. The requirement for Formal Drawings **will not** be held in abeyance.

### *Related-Patent Applications*

The continuing data in the related application section of the specification needs to be updated to reflect that parent application US Patent Application Serial No. 09/474,061 has matured into US Patent No. 6,350,379 and parent application US Patent Application Serial No. 09/398,459 has matured into US Patent No. 6,423,225.

### *Specification*

The following is a quotation of 37 CFR 1.71(a):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

The specification is objected to under 37 CFR 1.71 (a) because the claims claim a filter arrangement including a centrifugal separator; however, the specification fails to disclose that centrifugal separator. The abstract briefly mentions a centrifugal separator but fails to describe the centrifugal separator in any detail. Page 7, lines 8-17, of the specification discloses a second deflector in such a manner as it may well be the

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instantly claimed centrifugal separator. However, it is not completely clear that the second deflector and the instantly claimed centrifugal separator or one and the same.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-17 are rejected under 35 USC 112, 1<sup>st</sup> paragraph for the reasons given above in the objections under 37 CFR 1.71.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 13; since claims 13 depends from itself, claim 13 can not be understood and it is vague and indefinite as to what claim, claim 13 is supposed to depend from.

Regarding claim 14; the recitation of "the axis" lacks antecedent basis, and since a housing has more than one axis it is vague and indefinite as to which axis is "the axis".

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Yano et al.

Regarding claims 1 and 2; Yano et al. discloses an arrangement for filtering lubricating oil containing contaminants, the filter arrangement comprising: a first filter element (327) having a filter media, a second filter element (326) having a filter media; a centrifugal separator (354), the centrifugal separator also being a flow deflecting element; and a canister housing containing the first and second filter elements and the centrifugal separator mounted co-axial in the canister housing. (see Fig. 15)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

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1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over the embodiment of Fig. 15 of Yano et al. in view of the embodiment of Fig. 6 of Yano et al.

Regarding claim 14; the embodiment of Fig. 15 of Yano et al. discloses a filtering arrangement as discussed above but fails to disclose that the centrifugal separator comprises an array of fins which are oriented at an angle to the longitudinal axis of the canister housing.

Regarding claim 14; the embodiment of Fig. 6 of Yano et al. discloses a preferred centrifugal separator, the preferred centrifugal separator comprising an array of fins which are oriented at an angle to the longitudinal axis of a canister housing. It is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention to have included an array of fins in the centrifugal separator of the

embodiment of Fig. 15 of Yano et al., because that is the Yano et al.'s preferred type of centrifugal separator. (see col. 5, lines 49-62 of Yano et al.)

Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yano et al. in view of Lynch et al.

Regarding claims 1-17; Yano et al. discloses a filtering arrangement as discussed above but fails to disclose a centrifugal separator which is disposed upstream of at least a majority of the filter media of the first filter element.

Regarding claims 1-17; Lynch et al. discloses arrangement for filtering lubricating oil containing contaminants, the filter arrangement comprising: a filter element having a filter media; a centrifugal separator which is located upstream from the filter element, the centrifugal separator comprising an array of fins; and a canister which contains the filter element and the centrifugal separator. (see col. 1, lines 4-16)

It is considered that it would have been obvious to one having ordinary skill in the art at the time of the invention to have included the centrifugal separator as taught by Lynch et al. in the filtering arrangement of Yano et al. in order to swirl fluid around Yano et al's first filter element, thereby enhancing the efficiency of the first filter element.


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A Reifsnyder whose telephone number is (703) 308-0456. The examiner can normally be reached on M-F 9:00 AM to 5:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda M Walker can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-3601.

  
David A Reifsnyder  
Primary Examiner  
Art Unit 1723

DAR